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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 50277-1774	
Pursuant to 37 CFR 1.8(a)(1)(ii) I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via the electronic filing system in accordance with 37 CFR §§1.6(1)(4) and 1.8(a)(1)(i)(C) on the date indicated below and before 9:00 PM PST. on _____ Signature _____ Typed or printed name _____		Application Number 10/006,543	Filed November 30, 2001
First Named Inventor Rae K. Burns		Examiner Leslie Wong	
Art Unit 2164		Examiner Leslie Wong	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal. X</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided. X</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>57,181</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%; text-align: right;"> <u>/Daniel D. Ledesma#57181/</u> Signature <u>Daniel D. Ledesma</u> Typed or printed name <u>408/414-1080</u> Telephone number <u>April 9, 2008</u> Date </div> </div>			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☒ *Total of 1 _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Rae K. Burns, et al.

Confirmation No.: 1004

Serial No.: 10/006,543

Examiner: Leslie Wong

Filing Date: November 30, 2001

Group Art Unit: 2164

Title: TECHNIQUES FOR ADDING MULTIPLE SECURITY POLICIES TO A
DATABASE SYSTEM

Via EFS-Web
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

As will be seen from the discussion below, there is a clear error with respect to the Examiner's assertion that the evidence (including the declaration and exhibits) submitted under 37 C.F.R. § 1.131 on May 11, 2006 is insufficient.

Claims 1-5 and 21-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2002/0143735 to Ayi et al. ("Ayi") in view of U.S. Patent No. 5,787,428 issued to Hart ("*Hart*"). It is the Final Office Action's position that the evidence submitted is insufficient to establish a reduction to practice of the invention according to Claims 1-5 and 21-25 prior to the effective date of *Ayi* (page 2). The Final Office Action contends that the subject declaration (a) amounts to a general allegation and (b) lacks a statement of the facts demonstrating the correctness of the declaration, by the inventors, that the invention was reduced to practice prior to the effective date of *Ayi* (page 2). It is respectfully submitted that this is incorrect.

The Final Office Action (mailed October 29, 2007) and the Advisory Action (mailed March 24, 2008) fail to address any of the arguments presented in the response mailed on August 14, 2007.

On page 3, the Final Office Action referred to a statement from a prior response, which states:

Obviously, test script files and test script log files do not show the actual code that performs recited steps. Therefore, for example, it is difficult to show the step of “determining which policies...” and the step of “determining whether to perform the operation.” (emphasis added)

In response to this statement, the Final Office Action contends that “without correlating the limitations of at least the independent claims to Applicant’s Exhibits, the Applicant has failed to show possession of the claimed invention.” Representatives of the Applicants respectfully request the Examiner to point out in the CFR and/or MPEP where it is required that limitations of the claims must be correlated to exhibits. In fact, 37 CFR § 1.131 provides the standard for the sufficiency of a showing of a reduction to practice:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained. (emphasis added)

As is clear, an Examiner is not required to find a correlation between all the limitations in a claim and exhibits in order to find the sufficiency of a declaration under 37 CFR § 1.131. Rather, the standard is that the “showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference.”

Also on page 3, the Final Office Action quotes MPEP § 715.02, which states: “If the affidavit contains facts showing a completion of the invention commensurate with

the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient” (emphasis in the Final Office Action). **This section of the MPEP actually supports the Applicants’ position.** The present declaration satisfies the criteria specified in MPEP § 715.02, i.e., the declaration contains facts showing a completion of the invention commensurate with the extent of the invention as claimed.

For example, the declaration states:

3. We conceived and **reduced to practice an implementation of claims 1 – 5 and 21 - 25** before the effective filing date of Ayi.
4. We participated on a team that developed the implementation of **claims 1 – 5 and 21 – 25** that is incorporated into an Oracle™ database server product. After the design phase of the development, **successful tests were run to show that the implementation worked according to claims 1 – 5 and 21 - 25.** These tests, which were conducted using standard internal test processes and procedures, were completed before the effective filing date of Ayi and were carried out in this country.
(emphasis added)

Therefore, the declaration is sufficient.

On page 4, the Final Office Action provides patent office policy for actual reductions to practice under 37 CFR § 1.131, which office policy apparently states:

- a. Testing is required unless operativeness of invention is readily apparent.
- b. Testing, if required, must be under actual working conditions or realistic simulation of working conditions.
- c. Test results must be repeatable.

In support of this policy, the Final Office Action cited MPEP § 2138.05. However, MPEP § 2138.05 pertains to interference practice and 37 CFR 1.131 does not apply in interference proceedings (see MPEP 2138.01(III)). Neither the CFR nor the MPEP require testing in a Rule 131 declaration. Nevertheless, the inventors stated in the declaration that “**successful tests were run to show that the implementation worked** according to claims 1 – 5 and 21 – 25” (¶ 4; emphasis added). Furthermore, software

tests are clearly repeatable. If ¶ 4 of the declaration was considered by the Examiner, then it appears from this appeal for testing of the invention that the Examiner might want to personally witness tests being run. However, there is no such requirement. Instead, MPEP § 715.07(I) requires examiners to “consider all of the *evidence* presented in its entirety, **including the...declarations**” (emphasis added). Thus, because the declaration is also evidence of a reduction to practice of the invention, the declaration must be considered.

Finally, on page 4, the Final Office Action states that “the examiner cannot determine whether or not the reduced to practice invention is commensurate with the claims **without the nexus between the claim and the Exhibit. As a result, the Examiner has no basis to approve the affidavit**” (page 4; emphasis in the Final Office Action). It is respectfully submitted that the Examiner has ample basis to approve the declaration.

First, the statements by the inventors in the subject declaration are not hollow assertions. Rather, they are specific statements of fact. (Again see MPEP § 715.07(I) which states that evidence includes the declaration.) As such, the statements are considered evidence, each of which cannot be ignored.

Second, the courts have stated that “the PTO is required to accept Rule 131 Affidavits at **face value**, and **without investigation**” (see, e.g., *Herman v. Williams Brooks Shoe Co.*, 39 USPQ2d 1773, 1777 (S.D. N.Y. 1996); see also *Chisum on Patents* § 3.08[1][a] (2005); emphasis added). Based on the specific evidence provided in the declaration, the inventors have satisfied their burden to prove that a working implementation of the invention according to Claims 1-5 and 21-25 existed prior to the effective filing date of *Ayi*.

Third, MPEP § 715.07 states, “**An accompanying exhibit need not support all claimed limitations**, provided that any missing limitation is supported by the declaration itself.” Indeed, exhibits are not even required by 37 CFR § 1.131 or the MPEP. Exhibits A-D are either test script files or test script log files that show results of running the corresponding test script. The exhibits do not provide the actual code. However, neither the CFR nor the MPEP **require code to be submitted** in an exhibit, nor do the CFR and MPEP require a declaration to state word-for-word each claim limitation. To require a declaration to state word-for-word each claim limitation would be mere form over substance since Applicants may simply recite each claim limitation and state that such claim limitation was implemented before a certain date. Nevertheless, the **inventors have done effectively as much when referring** (1) specifically to Claims 1-5 and 21-25 in ¶ 3, 4, and 9 of the declaration and (2) implicitly in the remaining statements. Therefore, it is odd that the Final Office Action would assert that “the examiner cannot determine whether or not the reduced to practice invention is commensurate with the claims.” Contrary to this assertion in the Final Office Action, the Applicants have given “a clear explanation of the exhibits [in the declaration] pointing out exactly what facts are established and relied on by applicant.” MPEP § 715.07.

As stated above, the Patent Office is required to accept Rule 131 declarations at face value, without investigation. Based on the foregoing, it is respectfully submitted that the declaration and the accompanying exhibits are sufficient to prove a reduction to practice of the invention. Accordingly, it is respectfully request that the rejection of Claims 1-5 and 21-25 be reversed.